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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,025	06/01/2005	Kazuaki Tanimura	2005_0843A	1212

513 7590 10/23/2006

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EXAMINER

SAETHER, FLEMMING

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/537,025

Applicant(s)

TANIMURA, KAZUAKI

Examiner

Flemming Saether

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Election/Restriction***

Applicant's election of species A, claims 1-4, 8, 9 and 17-20 with traverse is acknowledged. Applicant's traversal is on the grounds that the restriction was based on US practice where as it should have been based on PCT lack of unity since the application was filed under 37 U.S.C. §371. However, applicant fails to indicate how the restriction is improper according to PCT rules. Applying PCT lack of unity, there must be the same inventive feature in all the claims for there to be unity and thus making restriction improper. In the claims of the instant application, this is not the case; all the claims do not include the same inventive feature. Specifically, all the claims do not define the same stopper and the generic "stopper" of claim 1 cannot be considered the inventive feature since it is simply not inventive as will be discussed below. Therefore in conclusion, the restriction requirement is proper according to both US and PCT rules and therefore is maintained. Accordingly, claims 5-7 and 10-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b).

As a formality, claims 5-7 should have been identified as --(withdrawn)-- even if it was with traverse.

***Specification***

The disclosure is objected to because of the following informalities: the title is not descriptive. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 8, 9 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the claim, it is unclear in which state applicant intends to claim the invention. Is the intent to claim the "fastener" in the state in which it exists prior to being installed on the fastening member or is the intent to claim it as it exists after installation. Specifically, claim 1 requires "releasing" the torque when the stopper is removed which contradict the stopper being fitted to the torsion spring as previously claimed. In other words, the stopper cannot be fitted to the spring at the same time there is a tightening torque applied to the fastening member. Similarly in claims 3 and 8, the cone shape cannot exist with the stopper fitted to the spring and in claim 2, "so as to be filled" implies that the stopper is not yet on the spring. Also, in claims 3 and 8, the claimed "means" is improper since there lacks a function and in claim 9, there is no antecedents basis for the stopper formed in a ring shape. The claims were examined as best understood as being directed to the fastener prior to assembly and if this is correct, applicant should consider using --adapted to-- type language when discussing the use of the fastener in combination with the fastening member for applying a torque.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanimura (US 6,257,813). Initially, it should be recognized that applicant's prior patent was patented on 7/10/2001 which is greater than 1 year prior to the 12/2/2002 effective filing date of the instant application; thus making it proper under §102(b). Now, as Tanimura applies to the claims, the embodiment of Fig. 10 discloses a fastener comprising a torsion coil spring (110) having a fixing end (112) and being attachable to a fastening member in the axial direction (at 111). There is further disclosed a detachable stopper (120) in the shape of the ring fitted to the outer periphery of the spring.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Mendenhall (US 1,301,958). In considering the embodiments of Figs. 6 and 12, Mendenhall discloses a fastener comprising a torsion coil spring (DA) having a fixing end (D<sup>5</sup>) and being attachable to a fastening member (CA) in the axial direction (at D<sup>4</sup>) and further discloses a detachable stopper (EA). Since Mendenhall discloses the same type spring as disclosed in the instant application it would be capable of expansion into the cone shape.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mendenhall as applied to claim 1 above, and further in view of Tanimura. Mendenhall disclose the stopper may be an "other releasable bond" than the disclosed clip but, does not disclose the ring shape. Tanimura discloses a similar device wherein stopper is shaped as a ring (120). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the device of Mendenhall with a ring shaped stopper as disclosed in Tanimura because the ring shaped stopper would be easier to install on the loaded spring by virtue of the simply being slipped over the spring.

***Allowable Subject Matter***

Claims 4, 9 and 17-20 appear would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The prior art of record does not disclose the ring shaped stopper being provided with a flange nor a groove at the insert end for the fixing end of the spring.


### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 571-272-7071. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Flemming Saether  
Primary Examiner  
Art Unit 3677